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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91201201
Party	Defendant Universal Master Products Limited
Correspondence Address	JEFFREY H GREGER LOWE HAUPTMAN HAM & BERNER LLP 1700 DIAGONAL RD , SUITE 300 ALEXANDRIA, VA 22314-2866 UNITED STATES
Submission	Motion to Consolidate
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of U.S. Application Serial Nos. 85/030,714; 85/030,683; 85/030,652

Applicant: Universal Master Products Ltd.

Marks: **ENDOCUBE; TCUBE; 3CUBE**

Publication Dates: November 23, 2010; April 19, 2011; April 19, 2011

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eCube Solutions, LLC

Opposer,

v.

Universal Master Products Limited

Applicant

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Opposition No.: 91199970

Mark: **ENDOCUBE**

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eCube Solutions, LLC

Opposer,

v.

Universal Master Products Limited

Applicant

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Opposition No.: 91201200

Mark: **TCUBE**

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eCube Solutions, LLC

Opposer,

v.

Universal Master Products Limited

Applicant

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Opposition No.: 91201201

Mark: **3CUBE**

**APPLICANT'S MOTION**

**TO CONSOLIDATE OPPOSITION PROCEEDINGS AND SUSPEND**

COMES NOW Applicant, Universal Master Products Limited, (hereinafter also referred to as Applicant) and files this Motion to Consolidate pending Opposition proceedings. The following Opposition proceedings are pending:

1. Opposition No. 91-199,970<sup>1</sup>

Application Serial No. 85/030,683

Mark: ENDOCUBE

2. Opposition No. 91-201,200

Application Serial No. 85/030,683

Mark: **TCUBE**

--and--

3. Opposition No. 91-201,201

Application Serial No. 85/030,652

Mark: **3CUBE**

All three Opposition have the same Defendant: Universal Master Products Limited; and Plaintiff: eCube Solutions, LLC

## **I. INTRODUCTION**

In the '970 Opposition, Applicant filed a trademark application for the mark ENDOCUBE covering a refrigeration temperature mimicking device. Opposer filed a timely opposition alleging a likelihood of confusion in view of Opposer's perceived rights in the registered mark eCube, Registration No. 3805518. Opposer's '518 registration for the mark eCube covers a refrigeration temperature mimicking device.

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<sup>1</sup> The '970 Opposition is currently suspended pending the disposition of civil litigation.

Concurrently, Opposer filed a lawsuit in the United States District Court for the District of New Jersey. In the Complaint filed in the lawsuit, Opposer alleges “UMP us in the process of soliciting additional distributors and/or customers of eCube to distribute and/or sell eCube® Marks, , [sic] or confusingly similar marks, including, but not limited to ‘tCube’, ‘3cube’, and ‘endoCube,’. . . .” Complaint, para. 38. In view of the co-pending district court litigation, on August 11, 2011, the Board stayed the pending Opposition pending final determination of the civil action between the parties. *See*, Aug. 11, 2011 Order.

Less than a week after entry of the Order staying the pending ‘970 Opposition proceeding, Opposer filed two more Oppositions on August 17, 2011 seeking to oppose registration of Applicant’s marks TCUBE and 3CUBE:

- Opposer filed an Opposition to Applicant’s mark TCUBE (Ser. No. 85/030683) based on a likelihood of confusion with Opposer’s mark eCube (Reg. No. 3805518), which was assigned Opposition No. 91201200; and
- Opposer filed an Opposition to Applicant’s mark 3CUBE (Ser. No. 85/030652) based on a likelihood of confusion with Opposer’s mark eCube (Reg. No. 3805518), which was assigned Opposition No. 91201201.

As such, the issues presented in Opposition Nos. 91-201200 and 91-201201 turn on nearly the same evidence as presented in the ‘920 Opposition. Additionally, the pending district court litigation may ultimately resolve the issues presented in Opposition Nos. 91-201200 and 91-201201. As such, it is within the Board’s sound discretion to consolidate the three pending Oppositions.

## **II. CONSOLIDATION IS PROPER IN THIS CASE**

For the reasons stated herein, the Board should exercise its discretion and consolidate the three pending Opposition Nos. 91-201200; 91-201201; and 91-199970.

**A. Legal Standard for Consolidation**

Fed. R. Civ. P. 42(a) provides for consolidation of the pending Oppositions. “If actions before the court involve a common question of law or fact, the court may: (1) join for hearing or trial any or all matters at issue in the actions; (2) consolidate the actions; or (3) issue any other orders to avoid unnecessary cost or delay.” Fed. R. Civ. P. 42(a); TBMP 511. When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. *See*, Fed. R. Civ. P. 42(a); *M.C.I. Foods Inc. v. Bunte*, 86 USPQ2d 1044, 1046 (TTAB 2008) (proceeding involved identical parties, identical registrations and related issues); *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997) (both proceedings involved the same mark and virtually identical pleadings); TBMP 511.

In determining whether to consolidate proceedings, the Board weighs the savings in time, effort, and expense, which may be gained from consolidation, against any prejudice or inconvenience that may be caused thereby. *See, e.g., Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010) (motion to consolidate granted); *World Hockey Ass'n v. Tudor Metal Products Corp.*, 185 USPQ 246 (TTAB 1975) (consolidation ordered where issues were substantially the same and consolidation would be advantageous to both parties).

Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *See, e.g., Dating DNA*, 94 USPQ2d at 1893; *Venture Out Properties LLC v. Wynn Resorts Holdings LLC*, 81 USPQ2d 1887, 1889 (TTAB 2007) (consolidation ordered sua sponte); *8440 LLC v. Midnight Oil Company*, 59 USPQ2d 1541 (TTAB 2001) (opposition and cancellation proceedings consolidated on Board's own initiative). Generally, the Board will not consider a motion to consolidate until an answer has been filed (i.e., until

issue has been joined) in each case sought to be consolidated. However, the Board may, in its discretion, order cases consolidated prior to joinder of issue. *Cf.* 37 CFR § 2.104(b); 37 CFR § 2.114(b).

**B. Consolidation Is Proper**

Under the facts of this case, the Board should exercise its discretion and consolidate the Oppositions. All three Oppositions are based on a single mark purportedly owned by Opposer (eCube). Applicant is concurrently filing its Answers to the Notice of Opposition Nos. 91201200 and 91201201, which were filed August 17, 2011. Consolidation of the pending Oppositions is proper because of the commonality of the issues of law and fact presented by the Oppositions.

Factually, the issues are nearly identical. Applicant and Opposer are the same parties in all three Oppositions. No additional parties are involved. The mark purportedly owned by Opposer is the same in all three oppositions.

The following facts are common to all three Oppositions and form the basis of the Affirmative Defenses and Counterclaims. Namely, Applicant adopted and used the mark (ECUBE) in the United States commerce prior to the filing date of Opposer's Reg. No. 3805518 (April 13, 2009). Applicant entered into a contractual agreement with a distributor whereby the distributor was provided limited distribution rights and authorization to distribute goods using Applicant's mark, namely ECUBE. Subsequently, Opposer obtained a sublicense from Applicant's distributor to use the ECUBE mark, but without Applicant's consent, as required under the terms of the agreement between Applicant and the distributor. The agreement between Applicant and the distributor has since terminated. Unexpectedly, Opposer filed for trademark registration in bad faith, knowing it was not entitled to use the ECUBE mark.

As such, the question of whether Opposer acted in bad faith in claiming exclusive ownership of the registered mark in the USPTO is identical in all three Oppositions. Additionally, issues of fact concerning Opposer's right to use the registered mark after Opposer's rights were terminated is a common question across all three Oppositions.

Legally, the issues are also nearly identical. For instance, Opposer's legal allegations found in Opposition Nos. 91201200 and 91201201 are nearly identical to those contained in the '970 Opposition. In all three Oppositions, Opposer's alleges nearly identical claims that Applicant's Marks (ENDOCUBE, TCUBE and 3CUBE) are likely to cause confusion with Opposer's Mark (eCube). Further, the Notices of Opposition contain nearly identically allegations that Opposer's Mark is distinctive and famous and registration of the Applicant's Marks is likely to dilute the strength of Opposer's Mark.

Furthermore, the Affirmative Defenses and Counterclaim for Cancellation of Opposer's registered mark, as alleged by Applicant in the '970 Opposition, challenges the validity of the same registration as asserted by Opposer in Opposition Nos. 91201200 and 91201201. All three Oppositions necessarily rely on the same challenged registration asserted by Opposer.

In view of the foregoing, the legal and factual issues are nearly identical across all three Oppositions, which weigh in favor of consolidation.

The Board should next weigh the savings in time, effort, and expense, which may be gained from consolidation, against any prejudice or inconvenience that may be caused thereby. *See, e.g., Dating DNA*, 94 USPQ2d at 1893. In this case, consolidation will reduce the time, savings, and expenses by a third given the identical factual and legal issues stated above. Consolidation of the three Oppositions will act to prevent duplicative discovery matters, prevent duplicative briefing and prevent duplicative Board hearings.

At this time, Applicant does not find any prejudice or inconvenience that may arise as a result of consolidation. The instant Opposition was recently filed, an Answer and Counterclaim entered, and the case was subsequently stayed pending the outcome of the district court litigation. Applicant concurrently files Answers in response to Opposition Nos. 91201200 and 91201201. As such, the instant Opposition is in nearly the identical procedural posture as Opposition Nos. 91201200 and 91201201. Moreover, all three Oppositions may be resolved by the district court litigation.

Should the Board grant this motion, Opposition Nos. 91-201200 and 91-201201 should also be stayed pending outcome of the district court litigation. In this manner, all three Oppositions will be on the same procedural footing.

### **III. CONCLUSION**

WHEREFORE, Applicant prays this Board GRANT the motion to consolidate all three Oppositions at this time, and concurrently stay Opposition Nos. 91-201200 and 91-201201 consistent with procedural posture of Opposition No. 91-199970.

Respectfully submitted,  
LOWE HAUPTMAN HAM & BERNER, LLP



Jeffrey H. Greger  
Attorney for Applicant

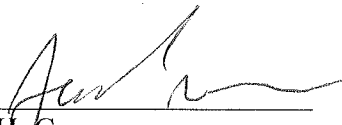
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September 16, 2011



**Certificate of Service**

I hereby certify that a copy of the foregoing Motion has been forwarded to Opposer's currently listed correspondence address and contact information according to the current records as contained in the U.S. Patent and Trademark Office records as appears below, by email this day of September 16, 2011 pursuant to agreement between the parties.

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Jeffrey H. Greger